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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/028781

09/21/08

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NEW YORK, NY 10114

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 09/09/08

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/028781

Applicant(s)

Walker et al.

Examiner

M. Sager

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE Three(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-104 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-104 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 23, 27, 36, 53, 55, 60, 85, 89 and 98 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 5,779,549. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-104 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U. S. Patent No. 5,779,549 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as

follows: a distributed electronic tournament system and a method of using a distributed electronic tournament system as claimed therein.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

5. Claims 1-104 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. This rejection is maintained from prior Office action, mailed Feb. 4, 1997.

The phrases "the tournament", "said controller", "the amount", "the attainment", "the number", "the starting", "the option", "the credit card account", "the outcomes", "the size", "the results", "the difficulty", "the present" and "the previous" either lack antecedent basis, are inconsistent with prior claim language or are indefinite for not claiming the metes and bounds of the invention.

The terms "about", "them" and "can" and phrases "being available", "for use", "will be", "to be" and "may be" are indefinite for not clearly claiming the metes and bounds of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 18, 20-21, 24-26, 28-29, 31-33, 40-41, 62-69, 80, 82-83, 86-88, 90-91, 93-95 and 102-103 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thacher et al.

This rejection is maintained from prior Office actions, mailed Feb. 4, 1997 and Nov. 7, 1997, of parent application 08/635,576 (now U.S. Pat. 5,779,549). Thacher teaches a tournament management system with communication between remote terminals and central computer clearly teaching claimed steps and features including performing bandwidth-intensive functions, as broadly claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-17, 19, 22, 30, 37-39, 42, 70-79, 81, 84, 92, 99-101 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thacher et al. This rejection is maintained from prior Office actions, mailed Feb. 4, 1997 and Nov. 7, 1997, of parent application 08/635,576 (now U.S. Pat. 5,779,549). Thacher teaches a tournament management system for dexterity based games (supra) except for features of claims 8-17, 19, 30, 37, 42, 70-79, 81, 92, 99 and 104. Regarding steps/features of claims 8-17, 19, 30, 37, 42, 70-79, 81, 92, 99 and 104, the examiner notes equivalence of features of claims 8-14, 19, 70-76 and 81 to features of claims 7 and 62, equivalence of features in claims 15-17, 77-79 to features in claims 7, 18 and 80, equivalence of features in claims 30, 37, 92, and 99 to features in claims 28, 31-32, 90 and 93-94 and equivalence of claims 42 and 104 with claims 40-41 and 102-103. The difference between these steps/features and that which is clearly taught in Thacher lie in the specific type of game and type

of play or of performance level recited and in the specific type of time limits used. As these features are merely variations of implementation of a tournament or gaming as are known, such would have been obvious to one of ordinary skill in the art in implementation of Thacher's tournament system. Absent criticality, specific choice of performance criteria or time limits fall within the realm of choice by game designers, when implementing a particular type of game onto Thacher's system. The lack of criticality of the specific recitations in the claims is evidenced by applicant's disclosure which further teaches these variations to be equivalent choices. Therefore, it would have been obvious at the time the invention was made to add the steps/features of claims 8-17, 19, 30, 37, 42, 70-79, 81, 92, 99 and 104 due to their equivalence with Thacher's tournament system.

Regarding claims 22 and 84, it is well known that the larger the number of participants in an event (e.g. social event or sporting competition) the more time and effort (i.e. relative difficulty) the function is to manage; analogously, if an event is restricted to a limited (maximum) number, the amount of time and effort to manage the event is limited. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add "below a preset value" as is well known to limit the relative difficulty necessary to manage the competition with Thacher's system in order to limit the management efforts necessary for a competition.

Regarding steps/features of claims 38-39 and 100-101, it would have been an obvious matter of design choice to add 'multiple windows... thereon' and 'preferences... window displaying the tournament' (clms 38-39 and 100-101), since the applicant has not disclosed that 'multiple windows... thereon' and 'preferences... window displaying the tournament' solves any

stated problem or is for any particular purpose and it appears that Thacher's system would perform equally well with 'multiple windows... thereon' and 'preferences... window displaying the tournament'.

10. Claims 34-35, 43-59 and 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thacher et al in view of Sabaliauskas. The examiner notes claims 43-61 parallel steps and features in claims 1-35, 36-42, 62-84, 86-88, 90-95 and 99-104 and therefore, the discussion above regarding claims 1-35, 36-42, 62-84, 86-88, 90-95 and 99-104 is incorporated herein.

Therefore, Thacher discloses an automated tournament management system comprising claimed steps/features (supra) except "qualifying event" (claims 34, 58 and 96), "determines if a player is eligible to participate... based on the results... participation" (claims 35, 59 and 97), and "means for determining... eliminated" and "means for permitting... session" (claim 43). Regarding claims 34-35, 43-61 and 96-97, qualification rounds and levels of play such as elimination rounds or as skill levels in competitions are so well known in the gaming industry to increase excitement to competition by adding levels of play. The background of applicant's disclosure admits in part "The world of... sports demonstrates the desirability of levels" and "sports use an elimination process to make the game more exciting for participants as well as spectators" (5:23 - 6:20).

Sabaliauskas discloses an automated tournament system which discloses elimination tournaments. The determining of players' eligibility to participate and the permitting of players to participate in subsequent round(s)/tournament(s) based upon current round/tournament performance are tournament administration steps very well known in gaming. Thacher teaches a tournament management system (supra) and Sabaliauskas teaches a tournament scheduling system including

scheduling for elimination round(s)/tournament(s) (supra). Therefore, it would have been obvious to an artisan of tournament gaming at the time the invention was made to add "determines if a player is eligible to participate... based on the results... participation" and "means for determining... eliminated" and "means for permitting... session" as is so well known in the gaming industry and as disclosed by Sabaliauskas and applicants' admission in the background with Thatcher's system in order to increase the excitement in the competitions for the players and spectators by adding levels of play.

Allowable Subject Matter

11. Claims 23, 27, 36, 53, 55, 60, 85, 89 and 98 appear to contain subject matter deemed patentable over art of record.

12. The following is a statement of reasons for the indication of allowable subject matter: regarding claims 23, 27, 36, 53, 55, 60, 85, 89 and 98, these cited claims also conflict statutorily with claims previously allowed by parent patented application (supra) and the reasons for indicating allowance of subject matter in cited claims is included in parent application cited above and incorporated herein.

13. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Conclusion

Response to Arguments

14. Applicant's arguments filed Feb. 24, 1998 have been fully considered but they are not persuasive. The examiner notes no filed preliminary amendments or arguments in application.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Breeding discloses a game with elimination and/or qualification rounds and is considered pertinent to applicant's disclosure.

16. This is a continuation of applicant's earlier Application No. 08/635,576 (now U.S. Pat. 5,779,549). All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Serial Number: 09/028,781
Art Unit: 3713

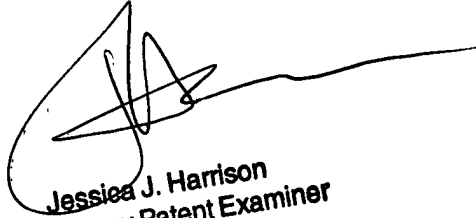
Paper No. 4
Page No. 9

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Jessica Harrison, can be reached on (703) 308-2217. The fax phone number for this Group is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


M. Sager
Patent Examiner
Feb. 18, 1999


Jessica J. Harrison
Supervisory Patent Examiner
Group 3700